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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,485	07/30/2001	Ulrich Gerber	003780-060	8847

7590

01/14/2003

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 01/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,485

Applicant(s)

GERBER ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8,10,13,14,16 and 17 is/are rejected.
- 7) ☐ Claim(s) 3,4,7,11,12 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The Status of Claims :

Claims 1-8 and 10-17 are pending.

Claim 9 has been withdrawn.

Claims 1-8 and 10-17 have been rejected.

***Election/Restrictions***

Applicant's election with traverse of Group I , claims 1-8 and 10-17 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that there is clearly absent an undue burden on the Examiner to examine all the claims in a single application. This is not found persuasive because there are two or more distinct, different classes involved in the search of the unrestricted claims. The search is a burden whether or not they are so closely related to their searches. Furthermore, M.P.E.P. Section 808.02 gives legitimate reasons for the Examiner to insist on restriction such as the case of separate classification, which indicates that "each distinct subject has attained recognition in the art as a separate subject for the inventive effort, and also a separate field of search .".

The requirement is still deemed proper and is therefore made FINAL.

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Claim 9 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

The disclosure is objected to because of the following informalities: "stericly" , line 5 on page 4 and "glykol" , lines 1 and 27 on page 11 ; line 15 on page 12 ; line 6 on page 13; line 3 on page 14. They have spelling errors.

Appropriate spelling correction is required.

Claim 10 is objected to because of the following informalities: "stericly" is written. However, the word is misspelled. Appropriate spelling correction is required.

### ***Claim Rejections - 35 USC § 112***

Claims 2 ,8,10, and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for one cyclic dicarboxylic anhydride, such as hexahydrophthalic anhydride, succinic anhydride, glutaric anhydride, and etc. , does not reasonably provide enablement for all kinds of dicarboxylic anhydrides. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to include all kinds of dicarboxylic anhydrides

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unrelated to the invention commensurate in scope with these claims. Therefore, an appropriate correction is required.

The specification, while being enabling for a saturated or unsaturated fatty acid, such as ricinoleic acid or castor oil, does not reasonably provide enablement for all kinds of the saturated or unsaturated fatty acids. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to include all kinds of the saturated or unsaturated fatty acids unrelated to the invention commensurate in scope with these claims. Therefore, an appropriate correction is required.

The specification, while being enabling for a polyol, such as neopentyl glycol, 1,3-propanediol, ethylene glycol, and etc., does not reasonably provide enablement for all kinds of the saturated or unsaturated fatty acids. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to include all kinds of the polyols unrelated to the invention commensurate in scope with these claims. Therefore, an appropriate correction is required.

The specification, while being enabling for an esterification catalyst, such as zinc acetate, zinc oxide, antimony trioxide, esters of titanate acid, and etc., does not reasonably provide enablement for all kinds of esterification catalysts. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to include all kinds of the esterification catalysts unrelated to the invention commensurate in scope with these claims. Furthermore,

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catalyst compositions represent an unpredictable aspect in the art of organic chemistry. See *Ex parte Sizto*, 9 USPQ2d 2081 (Bd. Of App. and Inter. March, 1988). Therefore, an appropriate correction is required.

Claims 1-2, 5-6, 10, 13-14, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" or "in particular" or "especially preferred" or "particularly preferred" or "preferably" or "exclusively" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 1 recites the broad recitation "in particular a group with 5 to 20 C-atoms, ", and the claim also recites "especially preferred the group – (CH<sub>2</sub>)<sub>7</sub>-CH=CH-CH<sub>2</sub>- " which is the narrower statement of the range/limitation.

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Claim 1 recites the broad recitation " in particular an alkyl group or an alkenyl group with preferably 2 to 20 C-atoms", and the claim also recites "particularly preferred the group  $-(CH_2)_5-CH_3$  " which is the narrower statement of the range/limitation.

Claim 1 recites the broad recitation " an aliphatic", and the claim also recites " in particular a cyclic aliphatic, or aromatic group " which is the narrower statement of the range/limitation.

Claim 1 recites the broad recitation " a linear or branched alkylene", and the claim also recites " in particular neopentylene " which is the narrower statement of the range/limitation.

Claim 1 recites the broad recitation " an optionally hydroxyl group substituted linear or branched alkylene group", and the claim also recites " in particular a neopentylene group " which is the narrower statement of the range/limitation.

It is recommended that the narrower statement of the range/limitation should be written in the dependent claims. Therefore, an appropriate correction is required.

Claim 2 recites the broad recitation " one dicarboxylic anhydride", and the claim also recites " in particular a cyclic dicarboxylic anhydride " which is the narrower statement of the range/limitation.

It is recommended that the narrower statement of the range/limitation should be written in the dependent claim. Therefore, an appropriate correction is required.

Claim 5 recites the broad recitation " one cyclic 1,2-dicarboxylic anhydride", and the claim also recites " in particular hexahydrophthalic anhydride " which is the narrower statement of the range/limitation.

It is recommended that the narrower statement of the range/limitation should be written in the dependent claim. Therefore, an appropriate correction is required.

Claim 6 recites the broad recitation " exclusively primary hydroxy groups", and the claim also recites " in particular neopentylglycol " which is the narrower statement of the range/limitation.

It is recommended that the narrower statement of the range/limitation should be written in the dependent claim. Therefore, an appropriate correction is required.

Claim 10 recites the broad recitation " one anhydride of a dicarboxylic acid", and the claim also recites " in particular a cyclic dicarboxylic anhydride " which is the narrower statement of the range/limitation. Furthermore, another broad recitation " the fatty acid", and the claim also recites " in particular one sterically hindered, secondary hydroxyl group " which is the narrower statement of the range/limitation. The third broad recitation " one polyhydroxyl compound", and the claim also recites " glycols " which is the narrower statement of the range/limitation.

It is recommended that the narrower statement of the range/limitation should be written in the dependent claims. Therefore, an appropriate correction is required.

Claim 13 recites the broad recitation " a cyclic 1,2-dicarboxylic anhydride", and the claim also recites " in particular hexahydrophthalic anhydride" which is the narrower statement of the range/limitation. It is recommended that the narrower statement of the



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range/limitation should be written in the dependent claim. Therefore, an appropriate correction is required.

Claim 14 recites the broad recitation " a polyol with exclusively primary hydroxyl groups", and the claim also recites " in particular neopentylglycol" which is the narrower statement of the range/limitation. It is recommended that the narrower statement of the range/limitation should be written in the dependent claim. Therefore, an appropriate correction is required.

Claim 17 recites the broad recitation " an entrainer ", and the claim also recites " in particular neopentylglycol" which is the narrower statement of the range/limitation. It is recommended that the narrower statement of the range/limitation should be written in the dependent claim. Therefore, an appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Kawai et al (JP10330470).

Kawai et al discloses the fatty acid-modified polyester polyol composition is obtained by reacting an 8-30 carbon fatty acid and a phthalic anhydride with an

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ethylene glycol (see a front page of abstract). Furthermore, the reaction takes place at temperature of 200 to 230<sup>0</sup> C. This is identical with the claims.

Claims 3-4, 7, 11-12, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

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January 10, 2003

  
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